

No. 15,855

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT
SYSTEMS, INC.,

Appellants,

vs.

SIDNEY S. RUBALOFF and ABRAHAM M. GROSS, individ-
ually and doing business as CHECK-A-MATIC Co.,

Appellees.

WM. T. ALVARADO SALES CO. and SPEE-DEE CHECKOUT
SYSTEMS, INC.,

Appellants,

vs.

DU-MORE FIXTURE Co., INC.,

Appellee.

BRIEF OF DEFENDANT-APPELLEE DU-MORE FIXTURE CO.

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BRIEF OF DEFENDANT-APPELLEE DU-MORE FIXTURE CO.

Introduction.

We agree with the appellants that "These cases raise the traditional issues of patent infringement case" (App. Op. Br. p. 3),* namely, the alleged validity of the patent

*For convenience the following abbreviations are used in this brief:

App. Op. Br. for Appellants' Opening Brief.

R. for the printed Transcript of Record. All page references are to the printed pagination.


Unless otherwise indicated, italics have been added to all quotations.

in suit and the alleged infringement of the accused devices. The simplicity of the statement of the issues, however, cannot serve to suppress the details of the evidence. That is, the contention of the appellants that there are both validity and infringement in this case as a matter of law (App. Op. Br. pp. 3, 33, 42-46) is simply divorced from the true facts in the record: Appellants' Opening Brief omits to record the evidence which is adverse to their contentions and distorts the evidence which it purports to recount.

The more important of the omissions and distortions will be specifically pointed out hereafter. Suffice it to say here (with particular reference to the Specifications of Errors, App. Op. Br. pp. 4-6) that there was no "*admitted* novelty of the patented device"; no "*admitted* insufficiency of the prior art to teach or suggest the combination of elements in the patented device"; no "*uncontroverted* evidence of novel coercion between the elements of the patented device"; no "*admitted* utility and improved action of the patented device"; no "*admitted* fact that the accused devices utilize the same concept of operation as the patented device for the same purpose as the patented device"; no "fact that the accused devices each included all of the elements defined by one or more claims of the patent in suit."¹

¹The italics are the appellants', and the listing in the text of statements of alleged facts in appellants' Specification of Errors which we dispute is not intended to be all-inclusive of the erroneous statements there. *E. g.*, also erroneous is the statement in specification 11, App. Op. Br. p. 5, "that the problem solved by the patent in suit had long been recognized by the trade and that in spite of this no one prior to the patentee had been able to conceive or devise the simple solution thereof as disclosed by the patentee." The alleged "problem" is how to speed up check-out of items purchased by customers at a "supermarket," which is stated to be "a matter of judicial record" and of long standing. (App. Op.

On the contrary, and by way of example, defendants always contended that the George patent was an unpatentable aggregation [*e. g.*, Par. XXII, R. 23, 44], and even the plaintiffs admitted that "*The parts are old, admittedly, but they are brought together in a novel action, as we intend to show.*" [R. 40; see also R. 42.] The only "admission" of the defendants was that "in a check stand George was the first one that put a panel over a quadrant of the turntable." [P. 458 of original Transcript of Proceedings in the District Court, reproduced in Appx. p. XVI of App. Op. Br.] This is not an admission of novelty of the patented device, nor of invention, nor of novel coaction. Beyond that, the "admission" is not coextensive with the reach of the claims of the George patent. The claims do not stop with merely calling for a turntable and a register support panel; they also include as an essential element a discharge counter, and as will be shown are invalid for overclaiming if for no other reasons. (See argument *re* overclaiming, *infra*.) Defendants consistently urged the invalidity of the George patent for overclaiming. [*e. g.*, R. 241.]

Br. p. 6.) The record in this case, however, contains mechanical conveyor type check-out stands long predating the patent in suit, *e. g.*, Muse patent No. 2,237,080, Bradley patent No. 2,317,438. The testimony was categorical that there was no substantial difference in checkout time through use of a belt-type conveyor compared with a turntable type conveyor. [R. 231.] Significant improvement of checkout time is obtained by mechanical over non-mechanical check stands, but not by one mechanical type over the other. [R. 231 and see text *infra*.] Mechanization of check-out stands, through inclusion therein of art from the field conveyors, was accomplished by Muse and Bradley at least twelve years before issuance of the patent in suit. 

Similarly, we do not pause now to comment in the text on the appellants' gratuitous assumptions as to what the trial Court allegedly failed to recognize and consider (*e. g.*, specifications 9 and 10). The case authorities showing the emptiness of these specifications are gathered hereafter in the argument.

Similarly, as a further introductory example, defendants denied with particularity that their device utilizes "the same concept of operation as the patented device." Thus, the testimony was categorical that the means of operation in defendant Du-More's device is an electric eye which halts movement of the turntable itself, and, as a consequence, stops the movement of the items which are on the turntable. There is no "stop portion"² of a register support in Du-More's device against which the articles will bump and come to rest: In Du-More the turntable is stopped, in plaintiff's claims the items, but not the turntable, are halted by a stop portion. [See generally R. 131-132.] This is a significant difference. In addition, the Du-More discharge counter has a straight edge [R. 133, 135], not one concavely arcuate with respect to the support panel. (Claim 3.) Nor is defendant's register support panel supported adjacent to the discharge counter [R. 138], as is the specification in Claim 5.

Further contentions of the defendants, the verity of which was proved by the evidence in the record, will be detailed hereafter.

Summary of Argument.

Although appellants have included thirteen "specifications of error,"³ we think it fair to say that their brief first argues that the George patent is a valid patent and

²Claim 3 of the George patent in suit. See also claims 6 and 7—"means forming a stop for articles on the receiving table" and "a side edge . . . to form an article stop for articles rotated thereagainst by said receiving counter."

³Some of these, we point out, cannot fairly be included in the "Appellants' Statement of Points to Be Relied Upon" [R. 243], but to the extent they are developed in appellants' brief we will answer them nevertheless.

then argues that defendants' devices infringe. Our argument, similarly, will first discuss the question of validity. Under this heading, the nature of the patent in issue as an unpatentable aggregation and the law governing aggregations will be set forth. The most recent opinions of this Court will be gathered to show that the George patent is not directed to an invention. Specific portions of the record will be cited to show that there are no new results, no marked increased efficiency, and no new coercion sufficient to support the patent. The prior art will be analyzed to show that all elements of the George patent are old and that the George patent was clearly anticipated thereby.

Our argument as a matter of excess caution will then develop that even if there is patentable invention somewhere in the device disclosed by the George patent, the claims in issue are invalid for overclaiming or vagueness.

Secondly, our argument will demonstrate that regardless of its validity the George patent is not infringed by the Du-More device. Under this heading the George patent will be analyzed in the light of file wrapper estoppel, a matter on which appellants' opening brief is significantly silent, though the matter was briefed at length in the trial court. When so analyzed, claims 3, 5, 6 and 7 of the George patent must be severely limited. Specific portions of the record will be cited to show that there is no infringement of any claim.

ARGUMENT.

I.

The George Patent No. 2,599,909 Is Clearly Invalid.

A. The Nature of the Patent in Suit.

(Ref. App. Op. Br. pp. 8-23.)

There is no dispute that this is a patent composed of elements all of which are old in the prior art. At the very inception of the trial the following colloquy occurred:

“The Court: Is there anything new in any of this apparatus? You have taken various items that have been in the public domain and combined them in something that you claim is new, but is there anything new?”

Mr. Webb: No.

The Court: Is there any part that is new, any claim of anything new?

Mr. Webb: Broadly speaking, your Honor, we do not claim any specific item is absolutely new and cannot be found in the prior art. We claim that the combination is new in this art and that it gets a new and un-obvious result, as we will show.” [R. 42.]

(We deal hereafter with the alleged improvement and un-obvious result to show they are not in fact present.)

The record was thereafter made specific by defendants to show the presence of all the elements in the prior art. A turntable is shown by the Price patent No. 2,268,897. [R. 391.] A moving surface to bring items to a checker in a store is shown by the Bradley patent, No. 2,317,438 [see Figs. 10 and 11 thereof; R. 404] and by the Muse patent, No. 2,237,080. [R. 387.] A cash register support adjacent to and to the right of where the articles may be taken by the checker is shown by the Turnham patent,

No. 2,242,408 [R. 416], by the Bradley patent, No. 2,317,438 [R. 404], and by the Muse patent, No. 2,237,080. [R. 387.] A “discharge counter” is shown by the same three patents last cited. Mechanization of the moving surface “receiving table” is shown in both Bradley and Muse in check-out stands and in the Price turntable in the food products industry. The Price device also shows a bar similar to a stop portion.

A careful reading of pages 8-23 of Appellants’ Opening Brief shows that appellants do not seriously controvert the above facts. Their argument rather is that there is novel interrelation and coaction of parts. Preliminary to discussing that argument, however, it is necessary to set out the actual record concerning the “mode of operation” of the check-out stands. (See App. Op. Br. pp. 11-12.)

B. The Mode of Operation Shown by the Device Disclosed by the Claims.

Appellants explain the mode of operation of the device by reference to their Exhibit 9. (App. Op. Br. p. 11.) It is important for the Court to realize that said exhibit was never represented as accurately reflecting *in scale* the devices in issue.⁴ Nor was there any testimony concerning a constant position or point at which the customers’ carts approach the stand, though it is of course true that customers generally approach the front of the checkstand rather than the side.

The customers load their items of purchase on the turntable, and place the items all over the surface thereof. not

⁴Appellants write: “Note that defendant appellees’ expert acknowledged the accuracy of the original exhibit at R. pp. 216-217.” (App. Op. Br. p. 11.) As the record shows, he acknowledged merely that the dotted arrows “accurately indicate the direction of motion of the articles relative to the checker.” [R. 217.]

merely at the periphery. [R. 106-108.] The intended operation of the device revealed by the George patent appears to be that the turntable will be in rotation only while activated by the checker [R. 114-115], who maintains in engagement a "hip switch" [R. 58, 96] or a foot pedal switch. [R. 96 and Item 24 in Fig. 1 of George patent, R. 250.]⁵ The turntable then rotates in a counter-clockwise direction, bringing the articles around and then towards the cash register support panel. Most articles will be brought to a position handy to the checker, but it is important to realize that items placed near the center of the turntable or significantly inward from the periphery of the turntable do not come within the deceptively easy reach of the checker depicted by Plaintiffs' Exhibit 9, and that said exhibit does not purport to be in scale to the actual physical reach of the checkers or to the comparative sizes of turntables and conveyor belts.⁶ In fact experienced checkers may have to reach a substantial distance for various items on appellants' device. For example, on cross-examination plaintiffs' witness Mrs. Kenney, a checker, testified in part as follows:

Q. With respect to the box of crackers you just picked up, the last item, that was near the center of the turntable, wasn't it? A. Yes.

Q. You had to reach a substantial distance across the turntable to pick that up? A. That is my habit. I check that way.

Q. But that is what you did, is that correct? A. Yes." [R. 60.]

⁵In contrast, the intended operation of defendant Du-More's device is that it be in constant rotation except when an item has interrupted the electric eye beam and thus broken the circuit. [R. 121.]

⁶The turntable made by plaintiffs is about 24 inches in radius. The usual conveyor belt is 18 inches or less. [R. 109.]

Regardless of whether the checker has to reach an uncomfortable distance for the items, in actual operation of plaintiffs' device there is a constant moving of the checker's head back and forth from the keys of the register to the surface of the counter. [R. 52, 59. "You have to look *both* places when you are checking."]

Further, the interruption of the items on the turntable by the checkers varies with the individual preference of the checker. The checker may pick up the item a considerable distance from the register, or may permit the items to come close to the register. The items may or may not be brought against the register support panel. [R. 58, 64-65, 89, 96, 198. See also testimony that operators have different preferred positions for the cash registers themselves. R. 75.] The checker operates the cash register with the right hand to record the price of the item and with her left hand she moves each item generally rearward from the turntable to the discharge counter.

When it is realized that the majority of belt type conveyors are eighteen inches or less in width [R. 109], and that items are placed all across said width [R. 107], and when it is realized that the operation of the plaintiffs' device is as above stated, it is apparent that, generally speaking, the items on a turntable type of check-out stand are brought to the same general position for check-out adjacent to the left of the checker as they would have been if transported from the front of the check-out stand towards the discharge counter by a conveyor belt; and that on both types of stands the items are "checked" on the cash register by the checker and then manually pushed or placed on the discharge counter in the same way.

C. The Validity of Such a Patent Is Governed by the Law Laid Down in the A. & P. Case and Its Progeny.

Especially in the light of the opinions of this Court within the last year, we would be carrying coals to Newcastle if we expounded at length “the rigid standards of invention of *Lincoln Engineering Co. v. Stewart-Warner Corp.*, *supra* [303 U. S. 545], and *Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corp.*, *supra* [340 U. S. 147]; . . .” *Moist Cold Refrigerator Co. v. Lou Johnson Co.*, 249 F. 2d 246, 252, 115 U. S. P. Q. 160, 166. This Court, and the trial courts of this Circuit, “are committed” to those rigid standards. (*Ibid.*) Most recently these standards have been elaborated in *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 116 U. S. P. Q. 32.

We therefore quote only the following extract from the *A. & P.* case, *supra*:

“The negative rule accrued from many litigations was condensed about as precisely as the subject permits in *Lincoln Engineering Co. v. Stewart-Warner Corp.*, 303 U. S. 545, 549 (37 U. S. P. Q. 1, 3): ‘The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention.’ To the same end is *Toledo Pressed Steel Co. v. Standard Parts, Inc.*, 307 U. S. 350 (41 U. S. P. Q. 593), and *Cuno Engineering Corp. v. Automatic Devices Corp.*, 314 U. S. 84 (51 U. S. P. Q. 272). The conjunction or concert of known elements must contribute something; only when the whole in some way exceeds the sum of its parts is the accumulation of old devices patentable. Elements may, of course, especially in chemistry or

electronics, take on some new quality or function from being brought into concert, but this is not a usual result of uniting elements old in mechanics. This case is wanting in any unusual or surprising consequences from the unification of the elements here concerned, and there is nothing to indicate that the lower courts scrutinized the claims in the light of this rather severe test.

“Neither court below has made any finding that old elements which made up this device perform any additional or different function in the combination than they perform out of it. This counter does what a store counter always has done—it supports merchandise at a convenient height while the customer makes his purchases and the merchant his sales. The three-sided rack will draw or push goods put within it from one place to another—just what any such a rack would do on any smooth surface—and the guide rails keep it from falling or sliding off from the counter, as guide rails have ever done. Two and two have been added together, and still they make only four.” (340 U. S. 147, 152-153, 87 U. S. P. Q. 303, 305-306.)

In the present case, as will be shown in detail in Part E hereafter, there is not within the meaning of the *A & P* case any different coaction between the various elements in the George device from the coaction of the elements in the prior art. The receiving counter or turntable in George has the same function as the belt in Muse and Bradley; the discharge counter in each serves the same function; and the coaction between the turntable and the discharge counter in George is precisely the same as the coaction between the belt and the discharge counter in Muse and Bradley. [R. 105-106, 191, 232-233.]

In the *A & P* case the Supreme Court's mandate was stated as follows:

"Courts shall scrutinize combination patent claims with a care proportioned to the difficulty and improbability of finding invention in an assembly of old elements." (340 U. S. 147, 152, 87 U. S. P. Q. 303, 306.)

In accordance with that mandate, patents far more colorable than the George patent have been held invalid by the Courts. The following is just a partial list of recent Ninth Circuit cases invalidating combination or aggregation patents:

- Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 116 U. S. P. Q. 32 (9 Cir., 1957);
- Container Corp. of America v. M. C. S. Corp.*, 250 F. 2d 707, 116 U. S. P. Q. 7 (9 Cir., 1957);
- Muench-Kreuzer Candle Co., Inc. v. Wilson*, 246 F. 2d 624, 114 U. S. P. Q. 203 (9 Cir., 1957);
- Oriental Foods, Inc. v. Chun King Sales, Inc.*, 244 F. 2d 909, 113 U. S. P. Q. 404 (9 Cir., 1957);
- Kwikset Locks v. Hillgren*, 210 F. 2d 483, 100 U. S. P. Q. 289 (9 Cir., 1954);
- Gratiot v. Farr Co.*, 237 F. 2d 940, 111 U. S. P. Q. 170 (9 Cir., 1956);
- Himes v. Chadwick*, 100 F. 2d 100, 106, 95 U. S. P. Q. 59, 63 (9 Cir., 1952);
- Berkeley Pump Co. v. Jacuzzi Bros., Inc.*, 214 F. 2d 785, 102 U. S. P. Q. 100 (9 Cir., 1954).
- Jacuzzi Bros. v. Berkley Pump Co.*, 191 F. 2d 632, 91 U. S. P. Q. 24 (9 Cir., 1951);

Photochart v. Photo Patrol, 189 F. 2d 625, 90 U. S. P. Q. 46 (9 Cir., 1951);

Hunter Douglas Corp. v. Lando Products, 214 F. 2d 372, 102 U. S. P. Q. 430 (9 Cir., 1954);

Thys Company v. Anglo California National Bank, 219 F. 2d 131, 104 U. S. P. Q. 230 (9 Cir., 1955).

It is not surprising that the above cases and standards are not discussed by appellants. It is surprising that they would contend that as a matter of law there is invention. This connection is disposed of alternatively:

Conclusion
(a) If invention, on this record, can be held to be a question of law rather than fact, it is clear that under the *A & P* case and *Bergman v. Aluminum Lock Shingle Corp. of America*, 251 F. 2d 801, 116 U. S. P. Q. 32 (9 Cir., 1957), this Court must rule that invention is lacking.

(b) To the extent that the record permits invention in this case to be an issue of fact (*e. g.*, if reasonable minds might differ as to whether the aggregation is suggested by the prior art or easily deduced therefrom, or because of testimony relating to degree of alleged improvement of plaintiffs' device over other types of check-out stands),⁷ the trial court has resolved the factual question and has held that there is no invention. This finding of fact will not be disturbed by this Court.

⁷We point out, however, that the comparisons of alleged improvement relied on by the appellants were of the turntable type of check-out stand over non-mechanical types of stands. Plaintiffs' witness McNeil claimed generally that the turntable was more efficient than other types of stands, but defendant's witness Garth was the only witness who explicitly compared turntable check-out stands with mechanized conveyor check-out stands. Garth testified categorically that there was no improvement in operation between the two. [R. 231.]

As stated in *Stauffer v. Slenderella Systems of California*, 254 F. 2d 127, 129, 115 U. S. P. Q. 347, 349:

“The sole question before this Court is whether the finding of fact by the trial court, that the Stauffer device is not patentable on the ground that it does not involve invention in view of the prior art, is ‘clearly erroneous.’ We conclude that the findings are sustained by the evidence and that the judgment must be affirmed.”

In support of this result this Court also stated in the *Stauffer* case:

“This Court has consistently held that the question of validity of a claim of a patent is one of fact. (citing cases) The findings of a judge upon novelty, utility and invention are entitled to great weight when made after a trial of these issues. This Court will respect such findings unless the record shows these to be ‘clearly erroneous.’ ” (254 F. 2d 127, 128, 115 U. S. P. Q. 347, 349.)⁸

D. No Principles of Law Cited by the Appellants Avoid the Impact of the Above Rigid Requirements.

1. Appellants seek to derive some comfort from their admission that “The structure of the patent in suit is not

⁸The cases cited for this rule were: *Oriental Foods, Inc. v. Chun King Sales, Inc.*, (9 Cir.), 244 F. 2d 909, 113 U. S. P. Q. 404; *Hall v. Wright* (9 Cir.), 240 F. 2d 787, 790, 112 U. S. P. Q. 210, 212; *Schmeiser v. Thomasian* (9 Cir.), 227 F. 2d 875, 106 U. S. P. Q. 213; *Jacuzzi Bros. v. Berkeley Pump Co.* (9 Cir.), 191 F. 2d 632, 91 U. S. P. Q. 24; *Leishman v. General Motors Corporation* (9 Cir.), 191 F. 2d 522, 91 U. S. P. Q. 190, cert. den., 342 U. S. 943, 92 U. S. P. Q. 467, rehrg. den., 343 U. S. 921, 343 U. S. 952; *Refrigeration Engineering v. York Corporation* (9 Cir.), 168 F. 2d 896, 78 U. S. P. Q. 315, cert. den., 335 U. S. 859, 79 U. S. P. Q. 455; *Maulsby v. Couzevoy* (9 Cir.), 161 F. 2d 165, 73 U. S. P. Q. 249, cert. den., 332 U. S. 791, 75 U. S. P. Q. 365; *Ralph N. Brodie Co. v. Hydraulic Press Manufacturing Co.* (9 Cir.), 151 F. 2d 91, 66 U. S. P. Q. 396.

complex” (App. Op. Br. pp. 8, 33) by arguing that “in fact simplicity is the essence of true invention.” (App. Op. Br. p. 33.) In support of this thesis the report of the Commissioner of Patents for the year 1849 is cited, including therein the authority of the poet Milton. Within the year the identical contention of another appellant before this Court was neatly disposed of as follows in *Stauffer v. Slenderella Systems of California, Inc.*, 254 F. 2d 127, 128, 115 U. S. P. Q. 347, 348-349:

“The argument of appellant is that simplicity is the essence of invention. For this proposition, numbers of cases are cited. But there is a common fallacy here. So common, indeed, that the medieval logicians gave it a name. All inventions may involve simplicity. But simply because a device is simple does not prove that it involves invention. The fact that the trial court indicated that none of the prior patents anticipated the device of Stauffer did not prevent him from considering the progress in the art thereby exemplified to determine whether invention were involved.”

2. Appellants cite the statutory presumption of validity and the fact that the Bradley and Price patents were cited by the Patent Office. (App. Op. Br. pp. 4, 5, 38.)⁹ This clearly cannot save an invalid patent.

Container Corp. of America v. M. C. S. Corp., 250 F. 2d 707, 708, 116 U. S. P. Q. 7, 8 (9 Cir., 1957), and cases there cited.

⁹Significantly, the Turnham, Muse, Goodrich and Florence patents were not made references of record in the file of the George patent. [See App. Op. Br. p. 15, and R. 254.] Significantly, also, appellants in the Patent Office cited the opinion of the Sixth Circuit on the Turnham patent [*Great Atlantic & Pacific Tea Co. v. Supermarket Equipment Corporation*, 179 F. 2d 636; file wrapper, p. 48 of George patent in suit; Du-More Ex. B], but not the reversal of that opinion by the United States Supreme Court (340 U. S. 147), though that reversal occurred during the prosecution of George's application.

3. Appellants cite the alleged commercial success of their device and the alleged copying by defendants. (App. Op. Br. pp. 5, 39.) Infringement, of course, is categorically denied, but even assuming that copying is present, neither copying nor commercial success can save an invalid patent.

Container Corp. of America v. M. C. S. Corp., 250 F. 2d 707, 709, 116 U. S. P. Q. 7, 8 (9 Cir., 1957);

Stauffer v. Slenderella Systems of California, Inc., 254 F. 2d 127, 128, 115 U. S. P. Q. 347, 349, and cases there cited.

4. Appellants argue that “the patent in suit is the first to teach the use of a rotatable turntable *in a checkstand* for self service stores.” (App. Op. Br. p. 22; see also p. 42: “No one ever used a rotatable turntable *in a checkstand* before.”) It is admitted, however, that rotatable turntables are old in the conveyor art and in the food packaging industry. [Price patent 2,268,897, R. 391, 236, containing specific admission.] It is also admitted that industrial type conveyors were made part of retail store operations in the Bradley and Muse devices [conveyor belts and rollers; R. 192-193, 404, 387]—before the George patent. The law is clear that the taking over of devices from one field of use to another does not constitute invention. A new use of an old device is not patentable.

General Electric Co. v. Jewel Incandescent Lamp Co., 326 U. S. 242, 249, 67 U. S. P. Q. 155, 158 (1945), and cases there cited.

5. Appellants argue that “the prior art failed to suggest the use of a turntable in the manner disclosed and claimed in the George patent in suit.” (App. Op. Br. p. 23; see also Point 14 in Appellant’s Conclusion, App. Op.

Br. p. 44, 38: “. . . the patents . . . suggested only the positioning of the Price turntable *alongside* of the cash register *but not partially under it.*” Italics by appellants.) Here appellants are both factually and legally incorrect. At R. 180-181 and 186-191 appellees’ expert explained how the turntable of Price would be substituted for the conveyor belt of Bradley and with defendants E series of exhibits [R. 309-315] graphically demonstrated what he had previously summarized in his direct testimony:

“Q. Would you point out the similarities, if any, and the differences, if any, between the Du-More checkout counter, such as shown in Defendants’ Exhibits D-1 and D-2, and the Turnham and the Bradley structures shown in the two patents? A. Well, the structures functionally are the same, with the exception again in the Turnham patent we have an extension which is a loading platform, over which the movable frame moves.

That has been replaced in the Du-More (302) construction by the rotatable turntable, which is a different type of loading platform.

Q. Is there any difference in co-action between the Du-More turntable, the cash register, and the discharge and the register support, and discharge counter shown in the Bradley patent? A. In the Du-More construction and in the Bradley patent, the loading elements comprise a turntable in Du-More and the conveyor belt in Bradley, and both function to convey the purchased material from the loading position to the checking position.

The function of the remainder of the unit is the same in the two cases, and far as I can see, it is merely a substitution of a rotatable turntable for the conveyor belt.” [R. 152-153.]

As to the law, this Court recently stated:

“The fact that the trial court indicated that none of the prior patents anticipated the device of Stauffer did not prevent him from considering the progress in the art thereby exemplified to determine whether invention were involved.

“Anticipation is strictly a technical defense. Unless all of the same elements are found in exactly the same situation and united in the same way to perform the identical function in a prior pleaded patent, there is no anticipation.

“The advances in the prior art may be such that, although there is no strict anticipation and even though the devices involved may not be similar, a trained mechanic would, if presented with the problem, solve it without difficulty. The court found affirmatively that the Stauffer device did not contain invention.”

Stauffer v. Slenderella Systems of California, Inc.,
254 F. 2d 127, 128, 115 U. S. P. Q. 347, 349 (9
Cir., 1957).

See also the discussion by Judge Mathes in *Delco Chemicals, Inc. v. Cee-Bee Chemical Co., Inc.*, 157 Fed. Supp. 583, 590, 115 U. S. P. Q. 403, 407 (S. D. Cal., 1957), and by the Seventh Circuit in *Goldman v. Bobins*, 245 F. 2d 840, 843, 114 U. S. P. Q. 137, 139 (7 Cir., 1957).

E. There Is No New Coaction of Parts or New Results.

In an attempt to avoid the impact of the facts and law stated above in headings “A” through “D,” appellants assert that there is new coaction between the old parts of their device and that there are new results sufficient to show invention. (App. Op. Br. pp. 13, 24, 36.) The

facts in the record and as found by the trial court are otherwise.

We take the paragraphs of pages 13 and 14 of Appellants Opening Brief in sequence:

Paragraph one on page 13 correctly describes the function of the rotatable receiving table but does so only if “the same convenient checking position” is understood to include the broad general area to the left of the register support panel. (See description of Mode of Operation under “B” above.) Items are brought to this “same convenient checking position” by the conveyor belt of Bradley and Muse. That apart, the description in paragraph one, of course, does not attempt to describe any coaction or any new results.

Paragraph two on page 13 in fact shows that the position of the register and of the checker in appellants’ device are identical with the position of the register and of the checker in the check-out stands shown by the prior art, with the difference only that the rotatable receiving table in part is under the register support. (This difference, and its inadequacy to show invention, has been discussed under “D” above.) Despite appellants’ euphemistic choice of language, it should also be pointed out (because of its pertinency to the issue of infringement) that in fact claims 3 and 7 expressly *require* that one portion of the register support panel operate as a stop portion and that claim 6 (claim 20 of application), because of George’s acquiescence in the rejection by the patent office [see pp. 31 and 34 of the file wrapper of 2,599,909, defendant Du-More’s Ex. B] also so requires. There cannot be a plurality of means for these functions under these claims.

Paragraph three on page 13 states the function of the discharge counter, but we do not believe that appellants seriously contend that conformation of the forward end of the discharge counter to the shape of the circular receiving table is a new coaction of parts. Conformation of parts one to the other has not been novel since man made his first structure or device. Rather, the coaction “in a novel manner” is described in the next paragraph, being *paragraph one on page 14*. There appellants state that the front of the discharge counter is within normal reach of the checker, that there is a continuous supporting surface for articles from the stop to the discharge counter, and that the articles can be merely pushed or swept from the checking position to the discharge counter. How “novel” all this is can be gleaned from those parts of the record quoted above and from the following:

The testimony of plaintiffs’ witness McNeil on cross-examination with reference to Plaintiffs’ Exhibits 7-D, 7-E, and 7-F is especially illuminating. [These exhibits show, respectively, a manually operated receiving counter, a belt-type receiving counter, and a turntable receiving counter, each connected with a discharge table..] At R. 105-106 after prior more detailed testimony is the following:

“Q. And in all three devices, the receiving counter, the particular mechanism that might be on the counter, such as the pull bar or pull arm in Exhibit 7-D, for the purpose of conveying articles to the location of the checker, is so she may reach the items with her left hand? A. That is the desired result in all cases.

Q. And in all three cases the checker will lift the articles, usually item by item, with her left hand and move them onto the discharge counter after record-

ing the value on the cash register? A. They are slid or lifted, yes.

Q. Slid or lifted, that's correct. A. Right.

Q. So insofar as that general co-action between the receiving counter and the discharge counter is concerned, and the checker is concerned, the general operation is the same in each of these counters? A. The very general operation, yes."

The testimony of defendants' witness Garth is also illuminating:

"Q. Is there any difference in the function of the discharge counter in the split type of stand shown in Du-More's Exhibit A, and the two-belt type stand shown in Defendant's Exhibit E, and which you have referred to as a disc type of check stand? A. No. They are all made of the same jigs.

Q. Do they all operate the same way? A. They all operate the same way." [R. 233-234.]

That the coaction of the various elements is the same in all the devices is also shown by defendant Check-A-Matic's Exhibits E-1 through E-8, depicting prior patents and devices and combining them to show the George device.

"Q. By Mr. Latta: Mr. Sellers, do you find in each of the stands in Exhibits E-1 to E-8, inclusive, a register support, a conveying device to bring articles to a checking position near the register support, and a discharge counter to receive checked articles where they can be placed in sacks? A. I believe that combination is present in each of these Exhibits E-1 to E-8, inclusive." [R. 191.]

What is said immediately above also disposes of *paragraph two on page 14*. We point out again, however, that the record does not support the statement that movement

of the articles of purchase is interrupted "closely alongside the cash register and immediately adjacent the discharge counter." This statement is true only if the general area to the left of the register support panel is meant thereby—the same general area from which articles will be taken from a mechanized conveyor belt by a checker. The same, of course, is true of the phrase "at the same location."

We now take the paragraphs of pages 24, 25 and 26 of Appellants' Opening Brief in sequence:

Paragraph one on page 24 contains statements which are simply not so. The parties to this suit agreed simply that mechanized check-out stands, both turntable and conveyor belt types, greatly facilitate the checking operation. The figures of a reduction of 25% to 33% in the number of checkstands needed referred to mechanized stands over non-mechanized stands, *not* to turntable stands over belt conveyor type stands.

The only detailed testimony comparing the increased efficiency of the various stands one to the other, and the only testimony specifically showing the source of any percentage increase in efficiency as reflected in the advertisements, was given by defendant's witness Garth. His testimony was as follows:

"Q. Mr. Garth, I notice in this same advertisement, Plaintiffs' Exhibit 30, there is a statement, 'Five Du-More Automatic Check Stands Do the Work of Eight Conventional Check Stands.' Did you have anything to do with composing the language that appears in the ad? A. Not the language. I did give the figures.

Q. To whom did you give the figures? A. To the advertising agency.

Q. To what does the expression eight conventional check stands refer, what type check stands are you referring to there? A. *A non-mechanical check stand.*

Q. By that you mean a non-turntable type? A. Non-turntable or non-belt type check stand.

Q. Would you be referring to a split type of check stand, such as shown in Defendant Du-More's Exhibit A? A. Yes.

Q. *Is there any substantial difference in the check-out time through use of a belt type conveyor, that is the type in which the receiving counter has a belt, such as shown in Defendants' Exhibit E for identification, and the turntable type of check stand?* A. No. The speed is regulated by the movement—or regulated actually by the checker. The movement of merchandise to the checker is usually much faster than she can handle it on the average order.

Q. So in the advertisement, then, the comparison is between a mechanical conveyor type of check stand to convey the articles to the checker's position, and a non-mechanical type? A. Right." [R. 230-231.]

(Even appellants' witness Phyllis Kenney compared the ease of operation of a turntable check-out stand only with a non-mechanical split type stand, not with a mechanized conveyor belt stand. [R. 57.] Appellees' expert stated he did not know the basis of the 30% figure. [R. 173].)

It follows, therefore, that the appellants' Spee-Dee check stand does not represent a marked improvement efficiency-wise over mechanized prior art check-out stands. That it is an improvement over split type stands is, of course, immaterial, as such stands were themselves greatly improved upon by the belt type mechanized stands.

There is, therefore, no basis in fact or law for plaintiffs' argument based on alleged increased efficiency.

(Increased efficiency alone in any event would be insufficient to justify a claim of invention. (*Oriental Foods, Inc. v. Chun King Sales, Inc.*, 244 F. 2d 909, 913, 113 U. S. P. Q. 404, 407 (9 Cir., 1957), and cases there cited).)

The phrase "to the same position immediately alongside of the cash register" in paragraph one on page 24 has been commented on above.

The attempt to prove greater visibility available to the checker, as in said paragraph one, is not supported by the record any more than is the statement on "improved result" and "a reduction of 25% to 33% . . ."

Even if we assume that operators have stiff necks and cannot turn their heads, the shaded portions on the turntable and belt on Plaintiffs' Exhibit 8 (which portions are alleged to be outside of "normal vision") are not significantly different in size. When it is remembered that many checkers pick up the items before they come to rest, the shaded portions must be reduced accordingly. In short, the "area of normal vision" includes the bulk of all items on both the turntable and belt conveyors.

In fact the shaded areas on Plaintiffs' Exhibit 8 must be further corrected by the obvious fact that the operator, even if she did not turn her head towards the counter and had a stiff neck, would not look over the top corner of the register but down at the keys. [See R. 65.]

The alleged "normal line of vision" of a checker, however, is itself a myth. Even plaintiffs' witnesses agreed that proper operation of the check-stand to insure accuracy and safety requires the checker to move her head

back and forth from the keys and the counter. Thus Mr. McNeil testified:

"A. Well, in spite of the fact that we do like cashiers who operate by touch, there are very few of them who are able to operate a machine by touch. It is very difficult, much more so than a typewriter or an adding machine. Because in this business accuracy is so completely important to the customer and to the retail customer, I mean to our customer, and the retail customer, we don't try to get the girls to look away from the machine, and they are operating the machine constantly, perhaps 10,000, actually, rings per day, so that a constant turning, as for example, watching—it is about like watching a tennis game, if you are to go back and forth from the items—having all the operation within or as close as possible to the normal line of vision is definitely a fatigue preventer." [R. 52.]

And Mrs. Kenney, the checker, testified as follows:

"Q. You don't look directly in front of you, you don't face head on into the cash register at all times. You are looking off to your left, isn't that correct?
A. You have to look both places when you are checking.

Q. So you can see the entire area of this turntable? A. Yes.

Q. As a matter of fact, you can see this fixed panel portion to your left of the turntable as well, can't you? You don't have any difficulty seeing that? A. No.

Q. You can actually see from the left half of the panel which supports the register all the way to the left side of the check stand, can't you? A. Yes." [R. 59.]

Paragraph two on page 24 of Appellants' Opening Brief is disposed of by what is said above about "the same convenient checking position," and by our recalling to the Court that Plaintiffs' Exhibit 9 is not to scale on the comparative sizes of turntables and conveyor belts. It can, indeed, be argued that there is better "reachability" on a conveyor belt type stand than on a turntable type, for in the latter the cash register may well impede the checker from reaching towards the center of the turntable.

Paragraph one on page 25 of Appellants' Opening Brief alleges an advantage which we believe is ridiculous on its face. That aside, there is no testimony in the record concerning alleged ease of identification of price. We also believe that this Court can take judicial notice of the fact that items are placed on check-out stands by customers without regard to where the prices thereon are stamped, and of the fact that many checkers in supermarkets register the prices of articles from memory and not from visual inspection of a stamped price.¹⁰

The summary *paragraph two on page 25* has been disposed of by the above comments on the preceeding paragraphs.

The argument in *paragraph three on page 25* is based entirely on the following testimony:

"Q. Has there been any recognized tendency in supermarket operations for the customers to rehandle articles on a belt type check stand? A. If you mean

¹⁰Indeed, most supermarkets provide their checkers with a list of prices which is attached to the register, for prices are changed frequently. When in doubt as to the price of an item, especially where "specials" are common, the checker will refer to her list and not to the price stamped on the item, if, indeed, any price is there stamped. There is, however, no relevant evidence on the "problem" in the record.

by rehandle, if you mean they *touch* them while they are on the stand, yes, there has been a very definite tendency.

Q. Is that an honest or a dishonest tendency?

A. Well, I don't know . . .” [R. 238-239.]

Clearly, this is not testimony that customers slip or move articles past the checker without the article being checked. *There is no testimony in the record* which supports the assertion that with appellants' stand “losses to the store have been greatly reduced.” (App. Op. Br. p. 26.)

Similarly, there is no testimony in the record to support the fanciful and insignificant argument dealing with carts in *paragraph one on page 26*. Beyond that, the description there is not in the claims nor anywhere in the George patent in suit.¹¹

Paragraphs one and two on page 36 of Appellants' Opening Brief simply restate, with the same factual distortions, some of the matters from pages 13-14 and 24-26, which are disposed of above.¹² We will not rehearse them. We point out, however, that even if there is new coaction between the turntable and the register support because of the latter's stop function, the claims of the George patent are more inclusive and are void for the reasons stated in “F” below.

¹¹Appellants' advertisements do talk of “nest cart space is scientifically provided in this Will L. George engineered *check-out system*.” [R. 281; see also R. 280, 293.] Obviously, this arrangement is not set forth in the patent.

¹²Paragraph two contains the additional inaccurate statement that all prior belt type checkout stands “moved articles longitudinally *past* the side of the checker.” As shown by plaintiffs' own Exhibit 9 [R. 262], the belt can terminate on a line with the register support panel so that items are not carried past the side of the checker.

We submit that a reading of this record cannot support any assertion that there is any new coercion of parts or any new results achieved by the device disclosed by the George claims in issue.

F. Even if There Is New Coaction Between the Turntable and the Register Support, the Claims Are Void for Overclaiming.

Page 36 of Appellants' Opening Brief and Point 5 of Appellants' Conclusion (p. 43) may be read as an attempt to argue that the inventive coaction present is between the turntable and the register support. We do not believe that this can be dignified to the status of invention under "the rigid standards of invention" discussed in "C" above. Be that as it may, such a constriction of appellants' arguments has a two-fold difficulty.

(1) Neither the specifications nor the claims of the George patent are so restricted. The specifications, in fact, emphasize the importance of the *discharge* portion of the stand and state in part:

"The important features of my check stand are the turn-table which brings each item of a purchase into convenient position alongside of the cash register for checking and the *curved shape of the discharge counter which permits the checker to move each item to the rear with a natural swinging motion of her arm and without turning to see where the item is placed.* The two features are mutually cooperative and *I prefer to combine the two*, but either may be used alone with highly desirable results." [George letters patent, col. 4, lines 38-54, R. 253; see also col. 1, lines 29-34, R. 252.]

The claims are just as clear that the discharge counter is an integral element of the device and that its coaction is essential to the protection sought. Thus, for example,

Claim 6 reads as follows [George letters patent, col. 6, lines 33-44, R. 253]:

“6. An apparatus of the class described comprising a rotatable receiving table, a stationary guard rail for a substantial portion of the rim of said receiving table, *a discharge counter disposed in the plane of said receiving table and having a portion thereof conformed to a segment of the table so that articles may be slid from the receiving table to the discharge counter*, means forming a stop for articles on the receiving table and a register support disposed above the plane of said receiving table at the side of said stop, and means for rotating said receiving table.”

(2) If plaintiff is now to be permitted to make his above constricted argument, then the principle of “overclaiming” requires invalidation of the George patent even if we assume that there is a novel coaction between the register support and the turntable (which appellees deny). The *A & P* case again is controlling.

In 340 U. S. 147 at 150, 87 U. S. P. Q. 303, 305, the Court stated:

“In the third place, if the extension itself were conceded to be a patentable improvement of the counter, and the claims were construed to include it, the patent would nevertheless be invalid for overclaiming the invention by including old elements, unless, together with its other old elements, the extension made up a new combination patentable as such. *Bassick Mfg. Co. v. Hollingshead Co.*, 298 U. S. 415, 29 U. S. P. Q. 311, 315-316; *Carbice Corp. v. American Patents Development Corp.*, 283 U. S. 27, 8 U. S. P. Q. 211.”

The principle referred to requires the patentee in his claims to specify and point out “the subject matter which

applicant regards as his invention.” (35 U. S. C. A. 112.) This requirement has been equated with the language in the old 35 U. S. C. A. 33, which provided that the inventor “shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.” See full discussion in *Winslow Engineering Co. v. Smith*, 223 F. 2d 438, 442-444, 106 U. S. P. Q. 209, 211-212 (9 Cir., 1955) (opinion adhered to on rehearing, 228 F. 2d 332). It is not a compliance with this section to claim the combination where only a particular element or factor is new; rather, if such is the claim the patent is void for overclaiming. See the following Supreme Court cases:

Graver Mfg. Co. v. Linde Co., 336 U. S. 271, 277, 80 U. S. P. Q. 451, 453;

United Carbon Co. v. Binney & Smith Co., 317 U. S. 228, 236, 55 U. S. P. Q. 381;

General Electric Co. v. Wabash Appliance Co., 304 U. S. 364, 368-371, 37 U. S. P. Q. 466, 468-469.

In the case at bar a reading of the claims in issue shows that the various elements are described in aggregation in terms of their previously known functions; no new element or factor is claimed, but merely the combination as a whole. Under the above cases there is clearly overclaiming and the patent must fall.

For recent applications of this principle by this Court, please see the following opinions:

Winslow Engineering Co. v. Smith, 223 F. 2d 438, 106 U. S. P. Q. 209 (9 Cir., 1955);

Jacuzzi v. Berkeley Pump Co., 191 F. 2d 632, 91 U. S. P. Q. 24 (9 Cir., 1951).

Judge Roche's opinion in *Butcher Boy Door Co. v. Phillips Products Co.*, 144 Fed. Supp. 331, 110 U. S. P. Q. 517

(N. D. Cal., 1956), especially at pages 336-337 of 144 Fed. Supp., is especially pertinent to the claims of the George patent.

Applying the above principles of "Overclaiming" to the precise claims of the George patent, we find that *in all the claims in issue* (3, 5, 6 and 7) the discharge counter has been included as an element—in direct contravention of the language above quoted from the *A & P* case, and despite the absence of any new coercion between receiving and discharge counters. Claim 5 is further void for overclaiming because it fails to specify inclusion of a stop portion; the language of this Court in *Winslow Engineering Co. v. Smith*, 223 F. 2d 438, 442, 106 U. S. P. Q. 209, 212 (1955), invalidates this claim even if plaintiff could otherwise show invention. Claim 6 is further void for overclaiming because it is too broad in not locating where the support and stop are—it is merely in terms of "above the plane of said receiving table," and the support and stop could therefore be completely disassociated from the rest of the device. As pointed out in *Graver Mfg. Co. v. Linde Co.*, 336 U. S. 271, 277, 80 U. S. P. Q. 451, 453 (and quoted in the *Winslow* case, *supra*, 223 F. 2d at 443) the specifications cannot be looked to save such a broad claim.

We respectfully conclude that for all the reasons stated in this part I of our brief, the George patent 2,599,909, must be held invalid as to claims 3, 5, 6 and 7 here in issue. We believe invalidity is shown as a matter of law under the cases cited above. Alternatively, we point out that the trial court after a contested trial made detailed findings which support the conclusion of invalidity. [R. 31-35.] Under the above cited cases this Court must affirm those findings and those conclusions.

II.

In Any Event Claims 3, 5, 6 and 7 of the George Patent Are Not Infringed by Defendant Du-More's Check-Out Stand.

A. The Structure and Operation of the Du-More Stand Should Be Accurately Stated.

Pages 31 and 32 of Appellants' Opening Brief distort the true structure and operation of the Du-More stand. The following facts are important to the question of alleged infringement if that question is reached:

(1) The register support panel in the Du-More device does not have "a stop portion along one edge thereof." Rather, the panel is so designed that registers placed thereon will overhang the edge of the support panel. [R. 132: "It is true that there is a support panel, which has an edge, over which, however, the cash register actually extends in use, and that edge need have no function." R. 230: "Because of the guide we put on the side, facing the register would be the right side, it forces the register over the panel just slightly." See also R. 143-144.] If any articles are stopped by striking an object in the Du-More stand, they strike, with minimal exceptions, the register and not the register support panel. George expressly disclaimed the register as part of his combination. [See renumbered p. 44 of the patent file, Deft. Ex. B.]

(2) In the Du-More device the turntable is normally rotating and is not started or stopped by the checker operating a switch or any other member. A halting of the turntable itself is caused by the breaking of the electric circuit by objects intercepting the light beam of the electric eye. The cessation of motion of the turntable of course brings the objects thereon to a halt—regardless of any stop portion or bar which might intercept the items (but

not the turntable). Thus, in George the items are intercepted on a moving turntable; in Du-More the turntable itself is halted by the electric eye device. Appellants state that this is so "in theory" but not in fact because of an overrun or inertia which caused the turntable "to carry any article against the side of the register support panel after the power was turned off." (App. Op. Br. p. 32.) The extent of this overrun was two or three inches at the perimeter of the turntable and less than that towards the center of the turntable. [R. 128.] And if any contact is made, it is with the register and not the register support panel. [R. 143-144.]

In this connection, too, we must point out that at page 41 of Appellants' Opening Brief, appellants quote only part of the answer of appellees' expert, so that his testimony is distorted by truncation.

"Would you identify that means which forms both a stop and register support in the George patent? A. Yes. In the George patent construction, that is the register supporting panel 28, which performs the double function of supporting the register and providing the stop.

Q. Would you identify the stop by a reference numeral? A. Yes. That bears the reference character 29 in figure 1.

Q. Do you find a similar or corresponding structure in the defendant Du-More's check stand? A. In the Du-More check stand, there is a register supporting panel, so indicated in figures 1 and 2 of Exhibit D-1. There is an edge of the panel which, if needed, could perform the function of a stop. *It is not functionally required, because the rotation of the turntable is stopped by the electric eye switch.*"

(3) Only if the George patent can be said to encompass merely a turntable in a check-out stand, and no other elements, are the statements in the full paragraph on page 32 of Appellants' Opening Brief true. In fact, however, the claims in suit include many more elements, as will be shown *infra*, and there is no infringement of any of them by the Du-More device.

B. The First Inquiry on the Question of Infringement Is to Construe the Claims of the George Patent in the Light of File Wrapper Estoppel.

Defendants-appellees emphasized the doctrine of file wrapper estoppel and it was a frequent subject of testimony and colloquy during the trial. [*E. g.*, R. 45, 178-180.] Appellants' Opening Brief is conspicuously silent on the doctrine of file wrapper estoppel but emphasizes the doctrine of equivalents.

The opinion in *Lewis v. Avco Mfg. Corp.*, 228 F. 2d 919, 923, 108 U. S. P. Q. 147, 150 (7 Cir., 1956), is directly in point on appellants' approach:

"As previously noted, we get from defendants' brief the definite idea that they do not dispute infringement under the doctrine of equivalents in the absence of file wrapper estoppel. At the same time, we note that plaintiff makes little effort to answer defendants' argument on the defense of file wrapper estoppel but hammers away on the theory that there is infringement under the doctrine of equivalents. In our view, this is a fallacious approach to the problem. It is akin to placing the cart before the horse.

"The doctrine of file wrapper estoppel, when applicable, supersedes that of equivalents. Its existence,

rightly or wrongly, protects an accused who otherwise might be guilty of infringement.”¹³

The principle of file wrapper estoppel, of course, is well known. It has been succinctly stated as follows:

“It is a rule of patent construction consistently observed that a claim in a patent as allowed must be read and interpreted with reference to claims that have been cancelled or rejected, and the claims allowed cannot by construction be read to cover what was thus eliminated from the patent.”

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U. S. 211, 220, 47 U. S. P. Q. 345, 349.

And in *Smith v. Magic City Kennel Club, Inc.*, 282 U. S. 784, 790, 8 U. S. P. Q. 123, 125-126, the Court stated:

“The applicant having limited his claim by amendment and accepted a patent, brings himself within the rules that if the claim to a combination be restricted to specified elements, all must be regarded as material, and that limitations imposed by the inventor, especially such as were introduced into an application after it had been persistently rejected, must be strictly construed against the inventor and looked upon as disclaimers. *Sargent v. Hall Safe & Lock Co.*, 114 U. S. 63, 86; *Shepard v. Carrigan*, supra, 598; *Hubbell v. United States*, supra, 85. The patentee is thereafter estopped to claim the benefit of his rejected claim or such a construction of his amended claim as would be equivalent thereto. *Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, 429.”

¹³Defendants here, of course, dispute infringement even in the absence of file wrapper estoppel. The doctrine, however, makes lack of infringement absolutely certain.

The doctrine of file wrapper estoppel applies not only to acquiescence in rejection of claims and substitution therefor, but also to arguments made by the patentee in the Patent Office in the process of obtaining a grant of letters patent.

D & H Electric Co. v. M. Stephens Mfg., Inc.,
233 F. 2d 879, 883, 110 U. S. P. Q. 469, 472
(9 Cir., 1956);

Jeoffrey Mfg., Inc. v. Graham, 219 F. 2d 511, 515-
516, 104 U. S. P. Q. 261, 265 (5 Cir., 1955);

Steffan v. Len A. Maune Co., 234 F. 2d 750, 752,
110 U. S. P. Q. 7, 8-9 (8 Cir., 1956);

Lewis v. Avco Mfg. Corp., 228 F. 2d 919, 923-928,
108 U. S. P. Q. 147, 152-154 (7 Cir., 1956);

Thabet Mfg. Co. v. Koolvent Metal Awning Corp.,
225 F. 2d 207, 210, 107 U. S. P. Q. 61, 64
(6 Cir., 1955).

C. When so Construed, Claims 3, 5, 6 and 7 of the George
Patent Must Be Severely Limited.

1. AS TO CLAIM 3:

By amendment [patented file, renumbered page 65, Deft. Ex. B] the following language was added to application claim 9, now patent claim 3: "said discharge counter extending longitudinally from said end *with its inner edge concavely arcuate* with respect to said support panel." The importance to applicant of the italicized phrase in said new language is seen from the argument he made on renumbered page 67 of the patented file. The patentee cannot now claim that the George patent covers a combination which includes a counter extending longitudinally from said end with its inner edge *straight* with respect to said support panel. The file wrapper thus emphasizes that

the means and manner of operation of the Du-More stand with a straight arm motion by the checker are different from the means and manner of operation of the George stand where there is a curved and allegedly "natural" arm swinging motion by the checker.

2. AS TO CLAIM 5:

Renumbered page 34 of the patented file shows that the following italicized phrase was added to claim 5 by amendment: "A register support panel supported above a quadrant of said turntable *adjacent to said counter* whereby said turntable will rotate freely in closely spaced relation and underneath said support panel." The argument of the applicant on renumbered page 51 of the patented file was that application claims 11 and 13 (now patent claim 5) include the base portion of the stand *and* the manner of supporting the register supporting panel *from the* turntable post and *discharge counter*. The patentee will not now be allowed to claim that register support panels not supported from the discharge counter are nevertheless covered by his claims. See full discussion in *D & H Electric Co. v. M. Stephens Mfg., Inc.*, 233 F. 2d 879, 883, 110 U. S. P. Q. 469, 472 (9 Cir., 1956).

3. AS TO CLAIM 6:

Application claim 20 (now patent claim 6) was amended, at patented file renumbered page 34, to call for the same single "means" to form a stop and a register support. Such amendment was made in compliance with rejection of such claim at renumbered page 31 that "Claim 20 is rejected as being deficient in twice claiming the same member, the article stop and the register support being one and the same element." It follows that in the following language of patent claim 6 plaintiff must be restricted to

a *single* means: "Means forming a stop for articles on the receiving table and a register support disposed above the plane of said receiving table at the side of said stop."

4. AS TO CLAIM 7:

The application claim 21, now claim 7, was added by amendment at patented file renumbered page 66 to include the same features as application claim 20 (now claim 6) with the "means for rotating said receiving table" omitted. Actually claim 7 expressly calls for the register support "having a side edge extending generally radially of said receiving counter to the periphery thereof to form an article stop." In connection with the doctrine of file wrapper estoppel, a claim added by amendment is in no different category than a claim which has been amended.

D. The Record Shows That There Is No Infringement of Any Claim.

(Ref. pp. 31-32, 40-41, and X-XIII of App. Op. Br.)

In determining infringement, it must be remembered that the burden is on the patentee-appellant and that *every* element of the combination must be embodied in the alleged infringing device.

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429, 444 (1926);

Lektophone Corporation v. Rola Co., 282 U. S. 168, 171, 7 U. S. P. Q. 107, 108 (1930);

Kwikset Locks, Inc. v. Hillgren, 210 F. 2d 483, 490, 100 U. S. P. Q. 289, 294 (9 Cir., 1954);

Simons v. Davidson Brick Co., 106 F. 2d 518, 523, 43 U. S. P. Q. 297 (9 Cir., 1939);

Montgomery Ward & Co., Inc. v. Rogers, 100 F. 2d 721, 722, 40 U. S. P. Q. 138, 139 (4 Cir., 1939).

It must be shown that there is substantial identity of means, mode of operation, and result; a difference in any one of these elements prohibits a finding of infringement.

Air Devices, Inc. v. Air Factors, 210 F. 2d 481, 483, 100 U. S. P. Q. 296, 297 (9 Cir., 1954).

1. AS TO CLAIM 3:

The Du-More device does not contain the following elements which are essential to Claim 3 of the George patent:

(a) “. . . a register support panel *having a stop portion along one edge thereof.*” As stated above, in George the turntable continues to rotate and articles are brought to a stop by impact against “a stop portion” of the register support; in Du-More, the turntable itself is brought to a stop and the impact of articles if any (because of the incidental overrun) is against the register and only rarely, if at all, against the register support. In short, there is no “stop portion” of the register support in Du-More. [See R. 131-132.] The register, having been expressly disclaimed as part of the George combination (see renumbered page 44 of the patented file), of course cannot be equated with a stop portion of the register support panel.

(b) “said discharge counter extending longitudinally from said end with *its inner edge concavely arcuate* with respect to said support panel.” Because of the amendment of his claims in the patent office, it will not lie with appellant now to argue that Du-More’s straight inner edge is the equivalent of George’s *concavely arcuate* edge. [See R. 133-135.] As shown on the cited pages of the Reporter’s Transcript, a checker using the George device swings her arm back in an arcuate manner and the items

come to rest behind her rather than rearwardly to her left. (This is also emphasized in the George letters patent, p. 1, col. 2, lines 36-47, and p. 2, col. 4, lines 43-51: “. . . the curved shape of the discharge counter which permits the checker to move each item to the rear with a natural swinging motion of her arm and without turning to see where the item is placed.”) A checker on the Du-More device, however, moves her arm backwardly in a straight line and the items come to rest rearwardly but to her left. Thus, the devices are operated in a different manner and accomplish a different placing of the items of purchase. This precludes a finding of infringement. *Air Devices, Inc. v. Air Factors*, 210 F. 2d 481, 483, 100 U. S. P. Q. 296, 297 (9 Cir., 1954), and cases there cited.

(c) “means for controlling said motor located behind said discharge counter for operation by the operator of said stand.” As explained above and by the witness Sellers [R. 136-137], the means for controlling the motor in Du-More in normal operation is the electric eye located above the turntable and not behind the discharge counter for use by the checker.

2. AS TO CLAIM 5:

The Du-More device does not contain the following element which is essential to Claim 5 of the George patent:

(a) “a register support panel *supported* above a quadrant of said turntable *adjacent to said counter* whereby said turntable will rotate freely in closely spaced relation and underneath said panel.” As shown in C-2 above, plaintiff is estopped by the patented file from arguing that Claim 5 covers a register support panel with a cantilever mounting, as Du-More has. [See R. 138-139.] Similarly,

the argument advanced at trial by appellants that the word "located" is meant by the claim rather than "supported" cannot be made. Indeed, this is the first time such meaning has been urged by the patentee, the file showing conclusively that the place of support was intended. At best this after-thought argument merely points up the fact that if such were the intended meaning of the claim, the claim must be held void for indefiniteness. A claim which requires such interpolation does not comply with Section 112 of the Patent Act of 1952, which requires the applicant to particularly point out and distinctly claim the subject matter which he regards as his invention.

Winslow Engineering Co. v. Smith, 223 F. 2d 438, 444, 106 U. S. P. Q. 209, 213 (9 Cir., 1955).

3. AS TO CLAIM 6:

The Du-More device does not contain the following element which is essential to Claim 6 of the George patent:

(a) "means forming a stop for articles on the receiving table and a register support disposed about the plane of said receiving table at the side of said stop." As shown in C-3 above, a single means is here required. But in the Du-More device the register support is not the means forming a stop for articles on the receiving table; rather, the electric eye stops the turntable itself, and any items at its periphery which may be incidentally stopped by impact strike against the register and only rarely, if at all, against the support. See R. 141 and the testimony of defendant's witness Garth: "Because of the guide we put on the side, facing the register would be the right side, it forces the register over the panel just slightly." [R. 230.]

4. AS TO CLAIM 7:

The Du-More device does not contain the following element which is essential to Claim 7 of the George patent:

(a) "A register support . . . having a side edge extending generally radially of said receiving counter to the periphery thereof *to form an article stop* for articles rotated there against by said receiving counter." Please see discussions above under Claims 3 and 6.

E. Summary on Infringement.

Especially in the light of the doctrine of file wrapper estoppel, it is obvious that defendant Du-More's device is not the equivalent of plaintiffs' claimed devices within the meaning of patent law. The means of stopping items in defendant's device is an electric eye which halts movement of the turntable itself and, as a consequence, stops the items on the turntable. There is no "stop portion" of a register support in defendant's device against which the items will bump and come to rest: In defendant's device the turntable is stopped. In plaintiff's claims the items are halted but the turntable continues to rotate. In short, there is no substantial equivalency of means, mode of operation, or result. In addition, defendant's discharge counter has a straight edge, not one concavely arcuate with respect to the support panel (Claim 3); and defendant's register support panel is not supported adjacent to the discharge counter. (Claim 5.)

What this Court stated in *Air Devices, Inc. v. Air Factors*, 210 F. 2d 481, 483, 100 U. S. P. Q. 296, 297 (9 Cir., 1954), applies here:

"The fact that the two devices accomplish the same result, or perform the same function, settles nothing about infringement. *Westinghouse v. Boyden Power*

Brake Co., 170 U. S. 537, 554; Cimiotti Unhairing Co. v. Am. Fur. Ref. Co., 198 U. S. 399, 414. Identity of result is no test. Stebler v. Porterville Citrus Assn. (9 Cir.), 248 Fed. 927. As the results obtained are not secured by the same means, or by a device operated in the same manner, or in substantially the same manner, the several devices are not equivalents. Leishman v. Associated Wholesale Electric Co. (9 Cir.), 137 Fed. 2d 722, 727 (59 U. S. P. Q. 1, 7).

“The judgment is affirmed.”

Conclusion.

Defendant Du-More submits that the George patent is clearly invalid because it is a mere aggregation, because of the doctrine of overclaiming, and because of the prior art. Even if the George patent is valid, defendant's device does not infringe the language and substance of the claims. Because of the proceedings before the United States Patent Office as set forth in the patented file, plaintiff is estopped to argue that the claims should be more broadly construed to cover the Du-More device.

Findings in accord with these conclusions were clearly required by the voluminous record; findings contrary to them would not be supported by the evidence. This Court should therefore affirm.

Respectfully submitted,

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